

APPLICANTS: J. Aruda, *et al.*
U.S.S.N.: 09/944,625

REMARKS

Amendments to the Claims

Upon entry of the present amendments, claims 26, 28-32, and 36 are pending. Claims 26 and 36 are amended herein; support for these amendments are found, *e.g.*, at page 7, lines 21-32, and in FIGS. 3(a), 3(b), 4(a) and 4(b) of the present application. Accordingly, the present amendments do not introduce new matter.

Each of the grounds for rejection cited in the Office Action is addressed below, under an appropriate sub-heading.

35 U.S.C. §103: Non-Obviousness

Claims 26, 28, and 36 were rejected under 35 U.S.C. §103(a) as being obvious in view of U.S. Patent 5,889,512 (Moller *et al.*). Additionally, claims 29-32 were rejected under 35 U.S.C. §103(a) as being obvious in view of the combination of Moller *et al.* and the description at page 2, lines 22-32, of the present application.

Of the pending claims, as amended, claims 26 and 36 are in independent form. The remaining claims depend from claim 26 and, therefore, incorporate its limitations.

Claims 26 and 28-32:

Claim 26 has been amended to specify that the cap is adapted to receive the first end of the elongated body and also adapted to receive the second end of the elongated body and to further specify that the second end of the elongated body cooperates with the cap to extend the non-writing tip outwardly from the second aperture as the cap receives the second end of the elongated body. FIGS 3(a) and (b) and 4(a) and (b) of the present application illustrate an embodiment of such a writing instrument, wherein the cap is adapted to receive the first end of the elongated body, as in FIGS. 3(a) and (b), and also adapted to receive the second end of the elongated body, as in FIGS. 4(a) and (b), and wherein the second end of the elongated body contacts the non-writing tip and forces it out of the second aperture in the cap.

In contrast, the writing element of Moller *et al.* does not include the cap described in amended claim 26. Further, Moller also fails to disclose a non-writing tip that is extended from

APPLICANTS: J. Aruda, *et al.*
U.S.S.N.: 09/944,625

the second aperture as the cap receives the second end of the elongated body. Rather, Moller *et al.* discloses an "extension" (14) mounted within the elongated body, itself. Moreover, in the design of Moller *et al.*, there is no disclosure of a cap adapted to receive the first end (where the writing surface is) of the elongated body. Nor is there any suggestion or motivation in Moller *et al.* for providing a non-writing tip in the cap or for configuring the apparatus such that that the second end of the elongated body cooperates with the cap to extend the non-writing tip outwardly from the second aperture in the cap.

Absent any disclosure, suggestion or motivation for such a design in Moller *et al.*, Applicants respectfully submit that claim 26, as amended, and all claims dependent therefrom are non-obvious over Moller *et al.*; accordingly, Applicants respectfully request that this ground for rejection be reconsidered and withdrawn.

Claim 36:

Claim 36 is amended to specify that the retractable tip is moveable between a position retracted within the second aperture and a second extended position extending out of the second aperture. Where the tip serves as a stylus, which typically is fairly sharp and which may be damaged if left exposed (or which may damage other component or injure the owner if left exposed), full retraction of the tip [as shown in FIG. 3(b)] is clearly advantageous.

In contrast, the very-fat end surface of the extension (14) in the writing instrument of Moller *et al.* clearly is not intended for use as a stylus, and its broad surface would not pose the same concerns with respect to safety and damage. Moreover, the extension (14) in the writing instrument of Moller *et al.* is intended to remain accessible to the user; therefore, there is no suggestion or motivation in Moller *et al.* for making the tip (if the extension could be equated with the tip) fully retractable into a cap.

Moreover, the description in the Background of the present application does not remedy these deficiencies in Moller *et al.* Consequently, Applicants respectfully submit that claim 36, as amended, is non-obvious over these references; and Applicants accordingly respectfully request that this ground for rejection against claim 26 be reconsidered and withdrawn.

APPlicants: **J. Aruda, et al.**
U.S.S.N.: **09/944,625**

CONCLUSION

On the basis of the foregoing amendments, Applicants respectfully submit that the pending claims are in condition for allowance. If there are any questions regarding these amendments and remarks, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,



Robert J. Sayre, Reg. No. 42,124
Attorney for Applicants
MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY and POPEO, P.C.
Address all written correspondence to
Customer No. 30623
Tel: (617) 542-6000
Fax: (617) 542-2241